REMARKS

Claims 1-45 were pending in the application. By this paper, Applicant has amended Claims 1, 3-4, 8-9, 12-13, 17-19, 21-26, 30-35, 38, 41, and 43, cancelled Claims 20 and 28-29 without prejudice, and added new Claim 46. Accordingly, Claims 1-19, 21-27, and 30-46 are presented for examination herein.

Previous Communication

The Office Action Summary Sheet lists the Office Action as being responsive to communications filed on November 24, 2008. However, Applicant can find no indication of a prior communication dated on or about November 24, 2008 in its files, or listed on the USPTO Patent Application Information (PAIR) Website. Applicant respectfully requests clarification as to the communication referred to by the Examiner.

Specification

Per page 2 of the Office Action, the Examiner has objected to the specification as containing cross-references which require updating. Applicant has herein amended the specification to correct the aforementioned cross references in the original specification as filed. Applicant has also amended the specification to correct editorial errors contained therein. Applicant submits that the aforementioned amendments do not add any new matter and overcome the Examiner's objections.

Claim Objections

Per page 2 of the Office Action, Claims 1-45 are objected to for containing one or more informalities. By this paper, Applicant has amended the claims to cure the informalities listed by the Examiner. Applicant submits that Claims 1-45 as amended herein overcome the Examiner's objections.

§112 Rejections

Per page 3 of the Office Action, Claims 9, 23-26, 31-33, and 34-37 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner objected to Claims 9, 23, 26, 31 and 34 as containing one or more terms which lack proper antecedent basis. By this paper, Applicant has amended Claims 9, 23, 26, 31 and 34 to provide appropriate antecedent basis for all of the terms. Applicant therefore submits that

5   Claims 9, 23-26, 31-33, and 34-37 overcome the Examiner's objections.

§102 Rejections

Per page 3 of the Office Action, Claim 38 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Fijolek, et al. (U.S. Patent No. 7,068,597; hereinafter referred to as

10   "Fijolek"). In response thereto Applicant provides the following remarks.

Claim 38 – By this paper, Applicant has amended Claim 38 to recite (i) a hardware registry comprising a singleton made part of middleware resident on the CPE, and (ii) the hardware registry being installed on the CPE after installation thereof in a consumer premises.

15   Support for this amendment may be found at, *inter alia*, page 19, lines 18-19 and lines 27-29 of Applicant's specification as filed.

Applicant notes that *"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."* *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

20   Cir. 1987). See MPEP 2131.

Applicant respectfully submits that Fijolek does not expressly or inherently disclose the aforementioned limitations. Specifically, Applicant submits that Fijolek does not expressly or inherently disclose a CPE having a hardware registry comprising a singleton made part of middleware resident on the CPE. Rather, Fijolek merely discloses a database 150 which stores

25   DHCP configuration settings and configuration data for all registered cable modems (col. 13, lines 25-27). As illustrated in Fijolek FIG. 5, the database 150 is a separate entity (located at the cable network headend) in communication with the CMTS 12, the CMTS 12 communicates with the CPE 18 via a cable modem 16 and the cable network 14. In other words, the database 150 is in no way disclosed as a component of the CPE 18. Hence, even if one assumes the

30   database 150 comprises a hardware registry (a point which Applicant does not necessarily

concede), the database 150 in Fijolek is not disclosed as <u>a singleton on the middleware of the</u> <u>CPE</u>.

Applicant further submits that Fijolek does not expressly or inherently disclose a hardware registry being installed on the CPE *after* installation of the CPE within a consumer

5   premises. Specifically, the database 150 in Fijolek is merely disclosed as an entity of the server cluster 147 (see e.g., FIG. 5 and col. 13, lines 18-22). Thus, even if one assumes the database 150 comprises a hardware registry (a point which Applicant does not necessarily concede), nowhere does Fijolek disclose the database 150 being installed on the CPE 18 after installation thereof within a consumer premises.

10   Therefore, Applicant submits that Fijolek does not expressly or inherently disclose all of the limitations of Claim 38 as amended herein. Hence, Claim 38 is respectfully not anticipated thereby.

§103 Rejections

15   1. Per page 5 of the Office Action, Claims 1, 8,-11, 13-18, 22 and 30-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baumgartner, et al. (U.S. Patent Publication No. 2002/0174433; hereinafter referred to as "Baumgartner") in view of Sweatt III, et al. (U.S. Patent Publication No. 2002/0038358; hereinafter referred to as "Sweatt"). In response thereto Applicant provides the following remarks.

20

Claim 1 – Applicant respectfully traverses the Examiner's §103 rejection of Claim 1 as being unpatentable over Baumgartner in view of Sweatt.

Applicant notes that *"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art."* In re Royka, 490 F.2d 981

25   (CCPA 1974). See MPEP 2143.03.

The Examiner contends that Sweatt discloses *"discovering said at least one hardware option and said at least one API using said application (First Module 132 page 12 paragraphs 0131/0132/0133)."* Applicant disagrees.

Sweatt does not teach or suggest discovering at least one hardware option <u>and</u> at least

30   one API using an application. Rather, at paragraph [0132] Sweatt discloses *"a first module 132*

providing the functionality of verifying whether the DVR 37 is properly registered to interoperate with the systems 10A and 10B." At paragraph [0133], Sweatt discloses "*A second module 134 provides the functionality of determining and extracting the pending requests for the particular DVR 37.*" Even if one assumes the verification of registration of the DVR in

5   Sweatt by the first module comprises discovering at least one hardware option (a point which Applicant does not necessarily concede), Sweatt does not disclose either module discovering at least one API. In other words, the modules 132, 134 disclosed in Sweatt merely verify registration of the DVR and extract pending requests particular to the DVR. Discovery of an API is not disclosed in any way that Applicant can see.

10   Therefore, Sweatt and Baumgartner do not, whether taken alone or in combination, teach or suggest all of the limitations of Claim 1.

The Examiner also contends that "*It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Baumgartner with the teaching of Sweatt, III ...*" Applicant disagrees.

15   Even assuming *arguendo* that Sweatt discloses discovering at least one hardware option and at least one API using an application (a point which Applicant does not concede), there is no motivation to combine the teachings of Sweatt with those of Baumgartner. Specifically, Applicant notes that "*The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of*

20   *the combination.*" *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (see also MPEP 2143.01). Applicant submits that it would not be desirable to combine the teachings of Baumgartner with a reference that teaches utilizing an application to discover the hardware <u>and</u> at least one API. Baumgartner discloses providing "intelligent APIs"; the APIs in Baumgartner are intelligent in that they are configured to determine the hardware being used (see e.g., Abstract, paragraphs

25   [0013], [0066], and [0068]). The API in Baumgartner are able to determine whether they are appropriate for the hardware (see e.g., paragraph [0068]) without requiring a separate application for discovering the hardware <u>and</u> discovering an API. Thus, there is no desire to combine Baumgartner with a reference which discloses an application for discovering both the hardware and the API.

Applicant further notes that *"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should <u>always</u> be considered in determining the obviousness of an invention under 35 U.S.C. § 103." In re Sponnable*, 405 F.2d

5   578, 585 (CCPA 1969) {emphasis added}. See MPEP 2141.02. Baumgartner is aimed at providing intelligent APIs which are able to determine the type of PVR device being used (see e.g., Abstract). In contrast, the problem identified and solved by the invention of Claim 1 is one of using an application that can be downloaded to a client device and run thereonto discover new or optional hardware, and an API to be used therewith for control of the hardware. Per

10   MPEP 2141.02, the Examiner is respectfully obliged to consider this evidence ("always"), and the record is devoid of such consideration.

Baumgartner does not appreciate the problem recognized and solved by the invention of Claim 1, thereby providing another independent basis for refuting the Examiner's obviousness rejection of Claim 1.

15

Claim 8 – Applicant respectfully traverses the Examiner's §103 rejection of Claim 8 as being obvious given Baumgartner in view of Sweatt.

The Examiner contends that Sweatt discloses application to *"(i) discover said hardware registry, said entries and said plurality of APIs (First Module 132 page 12 paragraphs*

20   *0131/0132/0133)."* Applicant disagrees.

Applicant submits that Sweatt does not teach or suggest discovering a hardware registry, a plurality of entries, <u>and</u> a plurality of APIs as recited in Claim 8. Rather, at e.g., paragraph 0132, Sweatt merely discloses a module 132 adapted to verify registration of the DVR. Even if one were to assume verification of the registration of the DVR comprises discovering a

25   hardware registry and entries thereof, nowhere does Sweatt disclose discovering a plurality of API.

The Examiner further contends that Sweatt discloses an application to *(ii) access at least one of said hardware features via at least one of said APIs ("analyzes the BereklyDB file...to match..."page 12 paragraph 0132)."* Applicant disagrees.

Applicant submits that Sweatt does not teach or suggest accessing at least one of the hardware features via at least one of the APIs. Rather at paragraph [0132], Sweatt merely discloses a module adapted to review the database in order to determine whether particular DVR has a serial number that matches one of the serial numbers in the database. If the serial numbers match, the DVR has been properly registered; if not, the DVR is not registered. Instead the module in Sweatt is merely aimed at determining registration of DVR devices. Once the module verifies registration of the DVR, Sweatt does not disclose the module performing any other actions, including accessing the DVR function via at least one API.

Applicant further notes that the second module *"provides the functionality of determining and extracting the pending requests for the particular DVR 37"* (paragraph [0133]). In other words, the second module merely accesses the pending requests. Nowhere is it disclosed as accessing at least one of the hardware features via at least one of the APIs.

Hence Sweatt and/or Baumgartner, whether taken alone or in combination, do not teach or suggest all of the limitations of Claim 8. Thus, Claim 8 is respectfully not rendered obvious given these references.

Claim 13 – Applicant respectfully traverses the Examiner's §103 rejection of Claim 13 as being unpatentable over Baumgartner in view of Sweatt.

The Examiner contends that Sweatt discloses software configured to *"provide access to said hardware options to at least one software application via a plurality of software interfaces ("analyzes the BereklyDB file...to match..."page 12 paragraph 0132)."* Applicant disagrees.

Applicant submits that Sweatt does not teach or suggest providing access to hardware options to at least one software application via a plurality of software interfaces. Rather at paragraph [0132] Sweatt merely discloses a module adapted to determine whether a DVR has been properly registered. Sweatt does not disclose providing access to the DVR (whether registered or not) to a software application via a plurality of software interfaces. Applicant further notes that the second module merely accesses the pending requests (paragraph [0133]), and is not in any way disclosed as providing access to the DVR to a software application via a plurality of software interfaces.

However, in order to more clearly distinguish the invention of Claim 13 over the prior art, Applicant has herein amended the claim to recite data relating to the hardware options comprising information regarding individual ones of the plurality of software interfaces which may be used to access individual ones of the hardware options. Support for this amendment may

5   be found at, *inter alia*, page 22, lines 23-31 of Applicant's specification as filed.

Applicant respectfully submits that neither Baumgartner nor Sweatt teaches or suggests the aforementioned limitation. The Examiner contends that Sweatt discloses maintaining a registry of hardware options including storing data relating to the options in a storage device at e.g., paragraphs [0131-0132]. Assuming, *arguendo*, the Examiner's contention to be correct,

10   Applicant submits that nowhere does Sweatt disclose the data comprising information regarding individual ones of the plurality of software interfaces which may be used to access individual ones of the hardware options. Rather, the data in Sweatt merely comprises requests from the various DVRs (see paragraph [0131]).

Therefore, Applicant submits Sweat and/or Baumgartner do not teach or suggest all of

15   the limitations of Claim 13 as amended. Thus, Claim 13 is not rendered unpatentable thereby.

Applicant further notes that it would not be obvious to one of ordinary skill in the art to combine the teachings of Baumgartner with a hardware registry comprising data regarding individual ones of the plurality of software interfaces which may be used to access individual ones of the hardware options. Specifically, there is no motivation to combine Baumgartner with

20   an entity for storing data regarding the software interfaces that can be used to access individual hardware options, because Baumgartner is specifically aimed at providing "intelligent" APIs which are configured to able to determine the type of PVR device being used. There is no need in Baumgartner for a hardware registry comprising data regarding individual ones of the plurality of software interfaces which may be used to access individual ones of the hardware

25   options; this fact provides another independent basis for refuting the obviousness of Claim 13 given the cited references.

Claim 22 – Applicant respectfully traverses the Examiner's rejection of Claim 22 as being unpatentable over Baumgartner in view of Sweatt.

The Examiner contends that Sweatt discloses *"discovering said at least one registry and software interface with said application, and responsive to said discovering, controlling said at least one hardware option using said application (First Module 132 page 12 paragraphs 0131/0132)."* Applicant disagrees.

5   Applicant submits that Sweatt does not teach or suggest discovering at least one registry and software interface with the application. Rather, the first module in Sweatt is merely disclosed as being adapted to verify whether the DVR is properly registered. Even if one assumes the verification requires discovering at least one registry, nowhere does Sweatt disclose additionally <u>discovering a software interface</u>.

10   Applicant further submits that Sweatt does not teach or suggest responsive to discovering, <u>controlling</u> the at least one hardware option using the application. Rather, as indicated above, the first module in Sweatt merely verifies whether a DVR is registered. Sweat does not disclose the module performing any other control functions once a DVR has been verified as being registered (or verified as not being registered).

15   Therefore, Applicant submits all of the limitations of Claim 22 are not taught or suggested by Sweatt and/or Baumgartner. Thus, Claim 22 is not rendered unpatentable thereby.

Claim 30 – Applicant respectfully traverses the Examiner's rejection of Claim 30 as being unpatentable over Baumgartner in view of Sweatt.

20   The Examiner contends that Sweatt discloses *"discovering said at least one registry and software interfaces with said application (First Module 132 page 12 paragraphs 0131/0132) and responsive to said discovering, controlling said at least one hardware option using said application (First Module 132 page 12 paragraphs 0131/0132)."* Applicant disagrees.

Applicant submits that Sweatt does not teach or suggest the aforementioned limitations.
25   Specifically, Sweatt does not disclose discovering at least one registry <u>and</u> software interfaces with the application. Rather, Sweatt merely discloses a module (first module 132) adapted to verify whether the DVR is properly registered. Assuming, *arguendo*, the verification requires discovering at least one registry, nowhere does Sweatt disclose also discovering a software interface. Further, Sweatt does not teach or suggest responsive to discovering, <u>controlling</u> the at 30   least one hardware option using the application. The first module in Sweatt merely verifies

whether a DVR is registered; the first module is not disclosed as performing any other functions (including controlling the DVR) once the DVR has been verified as being registered or not.

However, in order to more further distinguish Claim 30 over the prior art, Applicant has by this paper, amended the claim to recite selectively accessing, via the registry, individual ones of the plurality of hardware features which are standardized. Support for this amendment may be found at, *inter alia*, page 15, line 27 – page 16, line 2 of Applicant's specification as filed.

Applicant respectfully submits that neither Baumgartner nor Sweatt teaches or suggests selectively accessing, via the registry, individual ones of the plurality of hardware features which are <u>standardized</u>. Specifically, Sweatt merely discloses a module (first module 132) adapted to verify whether the DVR is properly registered. The first module is not disclosed as performing any other functions, including enabling selective access to the DVR. Further, even if one were to assume *arguendo* that Sweatt discloses selectively accessing individual ones of the hardware features (a point which Applicant does not concede), Sweatt does not disclose the individual ones of the DVRs being standardized as now recited in Claim 30.

Therefore, Claim 30 as amended herein distinguishes over the art of recording including Baumgartner and Sweatt and thus is not rendered unpatentable thereby.

Claim 34 – Applicant respectfully traverses the Examiner's rejection of Claim 34 as being unpatentable over Baumgartner in view of Sweatt.

The Examiner contends that Sweatt discloses *"discovering said at least one registry using said at least application, responsive to said discovering, controlling said DVR hardware using said application and said at least one interface (First Module 132 page 12 paragraphs 0131/0132)."* Applicant disagrees.

Applicant submits that Sweatt does not disclose discovering at least one registry <u>and</u> software interfaces with the application. Instead the first module 132 is merely adapted to verify whether a DVR is properly registered. Even if one were to assume such verification comprise discovering at least one registry (a point which Applicant does not necessarily concede), nowhere does Sweatt disclose <u>also discovering a software interface</u>. Applicant further submits that Sweatt does not teach or suggest <u>controlling</u> DVR hardware using the application and at least one interface as recited in Claim 34. As indicated above, the first module 132 in Sweatt

merely verifies whether a DVR is registered. No other functions are performed by the first module 132, including controlling the DVR hardware.

However, in order to more further distinguish Claim 34 over the prior art, Applicant has by this paper, amended the claim to recite the act of controlling via the application comprising

5   implementing one or more <u>user-specified rules</u> provided to said application relating to the playback of content from said DVR hardware. Support for this amendment may be found at, *inter alia*, page 26, lines 6-14 of Applicant's specification as filed.

Applicant respectfully submits that neither Baumgartner nor Sweatt teaches or suggests the act of controlling the DVR hardware using the application and the at least one interface

10   comprising implementing one or more user-specified rules that have been provided to the application relating to the playback of content from the DVR hardware, as now recited in Claim 34. Rather, as stated above, Sweatt merely discloses verification of DVR registration. There is simply teaching or suggestion in Sweatt of the module 132 controlling the DVR hardware including controlling the hardware by implementing one or more user specified rules given to

15   the application, the rules relating to the playback of content from the DVR.

Thus, Applicant submits all of the limitations of Claim 34 as amended herein are not taught or suggested by Sweatt and/or Baumgartner. Therefore, Claim 34 is not rendered unpatentable thereby.

20   2. Per page 15 of the Office Action, Claims 2-7, 12 and 23-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baumgartner in view of Sweatt, and further in view of Thompson, et al. (U.S. Patent Publication No. 2003/0229899; hereinafter referred to as "Thompson"). In response thereto Applicant provides the following.

25   **Claim 12** – Applicant respectfully traverses the Examiner's §103 rejection of Claim 12 as being unpatentable over Baumgartner in view of Sweatt and further in view of Thompson.

The Examiner contends on page 18 of the Office Action that Baumgartner discloses "*selectively control said at least one hardware feature using said software application (Step 608 page 5 paragraphs 0067/0071).*" However, at pages 11, 12 and 15 of the Office Action, the

30   Examiner has stated that Baumgartner does <u>not</u> disclose controlling a hardware feature using the

software application. Applicant notes the inherent contradiction in the Examiner's argument, and submits that Baumgartner does not in fact teach or suggest selectively controlling at least one hardware feature using the software application as recited in Claim 12.

At step 608, Baumgartner merely discloses selecting a set of APIs that correspond to the

5   PVR device for communication therewith. Even if one were to assume *arguendo* that communication between the PVR device and APIs comprises control of the hardware feature (a point which Applicant does not concede), the APIs do not comprise the software application referred to in Claim 12. In other words, the invention of Claim 12 relates to a software application running on the CPE which is adapted to selectively control at least one hardware

10   feature. The software application and hardware feature communicate via the APIs, but in Claim 12 it is the software application, and not the API, which controls the hardware. The software application cited by the Examiner (interactive television application described at Baumgartner page 3 paragraph 0045) is not in any way disclosed as being adapted to control at least one hardware feature.

15   Applicant further notes that per MPEP 2141.02 (see discussion of *In re Sponnable*, *supra*), Claim 12 is not rendered obvious where the references fail to appreciate the problem identified and solved thereby. The problem addressed by the invention of Claim 12 is one of using an application running on client equipment to control a plurality of hardware features of a CPE (including optional ones which may have been added later); the hardware features each

20   have an API associated therewith. Baumgartner is aimed at providing a library of intelligent APIs able to determine the type of device being used, and select an appropriate API (see e.g., Abstract). Thus, Baumgartner respectfully does not appreciate the problem recognized and solved by the invention of Claim 12, thereby providing another independent basis for refuting the Examiner's obviousness rejection of Claim 12.

25   To yet further distinguish the invention of Claim 12 over the prior art, Applicant has herein added limitations relating to: (i) the CPE being a third-party (versus MSO) CPE; (ii) the CPE comprising a plurality of proprietary and optional hardware features selected from the group consisting of: (ii) digital video recorder (DVR) features, and (digital video interface (DVI) features; (iii) the middleware being OpenCable (OCAP) compliant; (iv) the third party

30   CPE is configured to be utilized within a multiple systems operator (MSO) network; and (v) the

CPE being configured to receive the software application via download from said network <u>after</u> installation of said CPE with a consumer premises. Support for these amendments can be found at, *inter alia*, page 15, line 9 through page 16, line 2, of Applicant's specification as filed.

Applicant submits that none of the cited art teaches or suggests all such functions and features, whether alone or in combination. **Of particular note is the now-claimed ability of the retail/third party CPE of Claim 12 to have its proprietary DVR and/or DVI hardware features controlled (whether locally or remotely) by an MSO-provided application "after the fact"**. As discussed in Applicant's specification, such capability was not available in the prior art, including that cited by the Examiner.

Claim 23 –By this paper, Applicant has amended Claim 23 to recite selective download of the application being based at least in part on information contained in a profile of the client device. Support for this amendment may be found at, *inter alia*, page 20, lines 9-22 of Applicant's specification as filed.

Applicant respectfully submits that none of the prior art cited by the Examiner including Baumgartner, Sweatt and/or Thompson, teaches or suggests the aforementioned limitation. Specifically, at page 19 of the Office Action, the Examiner contends that Baumgartner discloses "*a process being adapted to selectively download an application to at least one client device (...programming modules that include PVR extensions 902...downloaded...)" page 9 paragraph 0086)*." Applicant submits that even if one assumes the Examiner's contention to be correct (a point which Applicant does not necessarily concede), nowhere does Baumgartner disclose the download of the application being based at least in part on information contained in a profile of the client device. Specifically, Baumgartner does not disclose a profile of the client device. Further, the extensions disclosed in Baumgartner are downloaded to <u>all</u> CPE regardless of any additional information.

Therefore, Claim 23 as amended herein distinguishes over the prior art including Baumgartner, Sweatt, and Thompson, and thus is in condition for allowance.

3. Per page 20 of the Office Action, Claims 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis (U.S. Patent Publication No. 2004/0103434;

hereinafter referred to as "Ellis") in view of Sweatt and Thompson. In response thereto Applicant provides the following.

Claim 19 – By this paper, Applicant has amended Claim 19 to recite the monitor
5   application being adapted to enable at least one external network entity to control the operation
of the CPE based at least in part on at least one event. Support for this amendment may be
found at, *inter alia*, page 26, lines 25-27 of Applicant's specification as filed.

Applicant submits that none of the references cited by the Examiner including Ellis,
sweat and/or Thompson teaches or suggests the monitor application being adapted to enable at
10   least one <u>external</u> network entity (e.g., an MSO entity or process) to control the operation of the
CPE based at least in part on at least one event. Specifically, Applicant notes that Ellis discloses
a screen 298 which merely displays a conflict and one or more options for its resolution. A user
may select one of the options to resolve the conflict (see paragraph [0152]). The screen 298
merely presents data to a user; it does not itself in any way function to control the operation of
15   the CPE (such as for example by resolving the conflict).

Therefore, Claim 19 as amended herein distinguishes over the prior art and thus is not
rendered obvious thereby.

4. Per page 23 of the Office Action, Claims 26 and 27 stand rejected under 35 U.S.C.
20   §103(a) as being unpatentable over Thompson in view of Sweatt. In response thereto Applicant
provides the following.

Claim 26 – By this paper, Applicant has amended Claim 26 to recite the records
providing at least information regarding (i) one or more parameters specific to at least one
25   hardware feature associated with the client device, and (ii) one or more application
programming interface (API) that can be used to access and manipulate the at least one
hardware feature. Support for this amendment may be found at, *inter alia*, page 15, lines 9-21 of
Applicant's specification as filed.

Applicant submits that neither Thompson nor Sweatt teaches or suggests records
30   providing information regarding one or more parameters specific to at least one hardware

feature <u>and</u> one or more API that can be used to access and manipulate the at least one hardware feature. Rather, per e.g., Sweatt paragraph [0132] a first module 132 is given for analyzes the BereklyDB file which contains a list of serial numbers for all DVRs that have registered. Even if one assumes the serial numbers comprise parameters specific to the hardware feature,

5   nowhere does Sweatt disclose the BereklyDB file also containing information regarding one or more API that can be used to access and manipulate the hardware feature.

Therefore, Applicant submits that Claim 26 as amended herein is not rendered obvious given Thompson and/or Sweatt whether taken alone or in combination.

10   5. Per page 24 of the Office Action, Claims 28 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baumgartner in view of Francis, et al. (U.S. Patent Publication No. 2004/0187152; hereinafter referred to as "Francis") and further in view of Thompson. In response thereto Applicant provides the following.

15   **Claims 28 and 29** – Without addressing the merit or propriety of the Examiner's rejection of these claims with respect to Baumgartner, Francis and/or Thompson, Applicant has by this paper cancelled Claims 28-29 without prejudice, thereby rendering the Examiner's rejections thereof moot.

20   6. Per page 26 of the Office Action, Claims 36 and 37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Baumgartner in view of Sweatt, and further in view of Carney, et al. (U.S. Patent Publication No. 2004/0003400; hereinafter referred to as "Carney").

Applicant respectfully submits that the Examiner's rejections of dependent Claims 36 and 37 are rendered moot, given the arguments and amendments discussed above with respect

25   to independent Claim 34.

7. Per page 28 of the Office Action, Claims 39 and 40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fijolek in view of Baumgartner. In response thereto Applicant provides the following.

Applicant respectfully submits that the Examiner's rejections of dependent Claims 39 and 40 are rendered moot, given the arguments and amendments discussed above with respect to independent Claim 38.

5   8. Per page 29 of the Office Action, Claims 41-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Sweatt, and further in view of Baumgartner. In response thereto Applicant provides the following.

Claim 41 – By this paper, Applicant has amended Claim 41 to recite receiving
10   contending requests for accessing the registry from two or more applications, and resolving the contending requests thereby enabling one of the two or more applications to access the registry at a time. Support for this amendment may be found at, *inter alia*, page 27, lines 3-13 of Applicant's specification as filed.

Applicant respectfully submits that none of the prior art cited by the Examiner, including
15   Thompson, Sweatt and/or Baumgartner, teaches or suggests the aforementioned limitation. For example, the Examiner contends that Thompson discloses an *"application adapted to run on said consumer electronics device and in conjunction with said middleware (ETV Application 1007 page 2 paragraph 0023-0026)"*. Applicant submits that even if one were to assume the Examiner's contention is correct (a point which Applicant does not necessarily concede),
20   nowhere does Thompson disclose receiving a request to access the registry from the ETV Application 1007. Still further, even if Thompson teaches the ETV Application 1007 requesting access to the registry (a point which Applicant does not concede), nowhere does Thompson teach or suggest receiving <u>contending requests</u> from two or more of such applications, and/or <u>resolving</u> the contending requests.

25   Therefore, none of the references whether taken alone or in combination teaches or suggests receiving contending requests for accessing the registry from two or more applications and resolving the contending requests thereby enabling one of the two or more applications to access the registry at a time. Thus, Claim 41 as amended herein is not rendered unpatentable given Thompson, Sweatt and/or Baumgartner.

30

Claim 43 – By this paper, Applicant has amended Claim 43 to recite the consumer premises device comprising a device not associated with the cable network, and the act of controlling being performed substantially by the cable network-provided application. Support for this amendment is replete throughout Applicant's specification as filed including at, *inter alia*, page 15, lines 22-27 thereof.

Applicant respectfully submits that none of the references cited by the Examiner teaches or suggests a consumer premises device not associated with the cable network and being controlled substantially by a cable network-provided application. Rather, in Thompson, the consumer premises device 1000 comprises set top box hardware 1001, an operating system 1003, middleware 1004, and an ETV application 1007. Per paragraph [0023], *"Operating system 1003 is an operating system software layer that allows <u>middleware software 1004 to access and control set top hardware 1001</u>. Middleware software 1004 provides a set of software application programming interfaces (APIs) that enable applications such as ETV application 1007 to operate on set top hardware 1001."* {emphasis added} In other words, middleware present on the consumer premises device controls the functionality of the device, and not a cable network-provided application.

Therefore, none of the references cited by the Examiner, including Thompson, Sweatt and/or Baumgartner, teaches or suggest all of the limitations of Claim 43 as amended herein. Accordingly, Claim 43 is not rendered unpatentable thereby.

9. Per page 32 of the Office Action, Claim 44 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Thompson in view of Sweatt, and Baumgartner, and further in view of Ellis. In response thereto Applicant provides the following.

Applicant respectfully submits that the Examiner's rejections of dependent Claim 44 are rendered moot, given the arguments and amendments discussed above with respect to independent Claim 43.

10. Per page 24 of the Office Action, Claim 45 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Carney in view of Wong, et al. (U.S. Patent No. 6,968,364;

hereinafter referred to as "Wong") and further in view of Baumgartner. In response thereto Applicant provides the following.

Claim 45 – Applicant respectfully traverses the Examiner's §103 rejection of Claim 45 as being unpatentable over Carney in view of Wong and Baumgartner.

The Examiner contends that Carney discloses "*configuring said CPE with one or more non-standardized hardware options (Set Top Box 16 page 4 paragraphs 0049, 0051-0053)*". Applicant disagrees.

Applicant submits that Carney does not teach or suggest one or more non-standardized hardware options. Rather, at e.g., paragraph [0049], Carney discloses a system to "*enable network operators to deploy a robust system for iTV applications and to allow application developers to populate those applications with dynamic data from various content sources. These applications can be authored once and run compatibly on multiple different types of set-top boxes 16*." {emphasis added} In other words, in Carney, the applications are purposefully standardized, i.e., they are purposefully configured to provide interoperability or compatibility across multiple set top boxes.

Applicant further notes that "*A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.*" *In re Haruna* 249 F.3d 1327, 1335 (Fed. Cir. 2001) (see also MPEP 2141.02). Applicant submits that a person of ordinary skill would be discouraged from providing non-standardized hardware options given the Carney disclosure as Carney is aimed at providing applications which may be used on (e.g. are compatible with) different types of set top boxes.

Therefore, Applicant respectfully submits that Claim 45 distinguishes over the prior art cited by the Examiner and hence is not rendered obvious thereby.

New Claims

By this paper, Applicant has added new Claim 46. New Claim 46 depends from previous independent Claim 41 and support for this claim may be found at, *inter alia*, page 27, lines 3-13 of Applicant's specification as filed. Applicant respectfully submits that no new

material has been added by way of new Claim 46 and that it distinguishes over the prior art cited by the Examiner and is in condition for allowance.

Other Remarks

5   Applicant hereby specifically reserves all rights of appeal (including those under the Pre-Appeal Brief Pilot Program), as well as the right to prosecute claims of different scope in another continuation or divisional application.

Applicant notes that any claim cancellations or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not 10   for purposes of overcoming art or for patentability. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Examiner, based on such cancellations or additions.
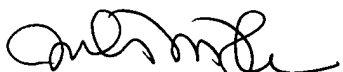
Furthermore, any remarks made with respect to a given claim or claims are limited 15   solely to such claim or claims.

If the Examiner has any questions or comments which may be resolved over the telephone, he is requested to call the undersigned at (858) 675-1670.

Respectfully submitted,

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GAZDZINSKI & ASSOCIATES, PC

Dated: July 2, 2009   By: _____
25   Julie M. Flores
                                            Registration No. 58,559
                                            Attorney of Record
                                            11440 West Bernardo Court, Suite 375
                                            San Diego, CA 92127
30   Telephone No.: (858) 675-1670
                                            Facsimile No.: (858) 675-1674